

REMARKS

Reconsideration of the pending application is respectfully requested in view of the foregoing amendments and the following remarks.

Status of the Application

Claims 1-17, 19 and 21-37 are currently pending, with claim 27 being amended to address a typographical error. No new matter has been introduced into the application by way of this amendment.

Summary of the Office Action

The Office Action rejects claims 1-9, 13 and 21-25 under 35 U.S.C. § 102(b) as anticipated by JP 05-127402A ("Umeda"), citing polymers (II)-105 and (II)-127.

Claims 1-6, 9-12, 14, 15, 19, 21-28 and 31-17 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Published Patent Application 2001/0009129 ("Kunita") in view of U.S. Patent 5,837,785 ("Kinsho").

Claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as being obvious over Kunita and Kinsho as applied to claim 15, and further in view of applicants' admitted prior art.

Claims 7, 8, 13, 29 and 30 are rejected under 35 U.S.C. § 103(a) as being obvious over Kunita and Kinsho as applied to claims 1 and 15, and further in view of Umeda.

Discussion

Applicants respectfully traverse the foregoing rejections for the following reasons. The Office Action contends that the polymers identified by (II)-105 and (II)-127 in Umeda anticipate the polymers described in the claims. However, from the machine translation of Umeda (submitted herewith), these compounds are not polymers, but are instead examples of typical antioxidants (of relatively low molecular weight). *See, e.g., Umeda machine translation ¶¶[0018]-[0029] & Table 4 which identifies the compounds of Formula (II) as antioxidants, and not as polymers.* For this reason, the rejection of claims 1-9, 13, 21-25, 29 and 30, based on Umeda in whole or in part, should be withdrawn.

Turning to the rejections based on Kunita, Applicants submit that Kunita discloses (at ¶[0193] on page 35) "... to use as the binder polymer, a polymer having heterocyclic group that has unsaturated bonds in the ring." At ¶[0197], Kunita further discloses that this heterocyclic group is bonded to the side chain of the polymer ..." or, preferably, "... bonded to the main chain via appropriate linking chains ..." and "... preferred examples of linking chains include a.o. thioether bonds ..." Kunita further discloses in ¶[0197] that "...

examples of polymer main chains include a vinyl polymer as a side chain of poly(meth)acrylate, polystyrene and polyvinyl acetal, polyester and polyurethane, a polyvinyl polymer is preferably"

There is no disclosure or teaching in Kunita that the polymer having a heterocyclic group is a polymer comprising a phenolic monomeric unit.

Applicants respectfully disagree with the statement in the Office Action that ". . . but they are silent in regards to the main polymer, implying that one having ordinary skill in the art could choose an appropriate polymer main chain." *See Office Action, p. 3.* This statement is incorrect because Kunita discloses a list of polymer main chains, namely "poly(meth)acrylate, polystyrene and polyvinyl acetal, polyester and polyurethane, a polyvinyl polymer is preferably". Notably, this list does not contain a polymer having a phenolic monomeric unit.

Applicants further respectfully disagree with the statement in the Office Action that "Kunita et al. further teach the use of Novolac polymers in their invention in paragraphs 191-192." *See Office Action, p. 3.* The basis for this disagreement is that these novolac polymers have nothing to do with the selection of polymers of the embodiment of ¶[0193]. Indeed, the selection of polymers of the embodiment of ¶[0193] are disclosed in last sentence of ¶[0197].

It is respectfully submitted that the only means of justifying the positions set forth in the Office Action is by improperly picking and choosing elements from different lists, which have nothing to do with each other, so that the claimed invention is provided. This approach is pure hindsight, and is not permitted. There must be a teaching or suggestion in the prior art itself that would motivate one skilled in the art to make the modifications asserted in the Office Action. As no such suggestion is present, however, the rejections cannot properly be sustained. .

Moreover, in Kinsho, Applicants submit there is no disclosure or suggestion which would motivate one skilled in the art to provide a heterocyclic group bonded by a thioether bond to the phenyl group of a phenolic monomeric unit of a polymer. Again, hindsight analysis is the only basis upon which the rejection can be justified.

For the foregoing reasons, independent claims 1 and 15 (and the other claims dependent thereon) are patentable over the prior art of record. Withdrawal of the rejections is, therefore, respectfully requested.

Conclusion

As Applicants believe the application is in proper condition for allowance, the examiner is respectfully requested to pass the application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Christopher T. Griffith, Reg. No. 33,392
LEYDIG VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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